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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/584,398	07/05/2007	Masayuki Tsutsumi	358362011300	9225
25227 7590 12/01/2009 MORRISON & FOERSTER LLP 1650 TYSONS BOULEVARD SUITE 400 MCLEAN, VA 22102				
EXAMINER				
FANG, SHANE				
ART UNIT		PAPER NUMBER		
1796				
MAIL DATE		DELIVERY MODE		
12/01/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/584,398

**Applicant(s)**

TSUTSUMI ET AL.

**Examiner**

SHANE FANG

**Art Unit**

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9, 11-19 is/are pending in the application.
- 4a) Of the above claim(s) 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11 and 13-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB06)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ ~~Notice of Informal Patent Application~~
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Amendment*

- The amendment of claim 5 has been found supported by specification 0017.
- The previous claim objection has been overcome by amendment.
- The previous 102 rejections of claims 5 and 18 over Dalman have been **maintained**.
- The previous 102 rejections of claims 5 and 18 over Harris et al. have been **maintained**.
- The previous 103 rejections of claims 1-4, 6, 11, 13-14, and 17 over Dalman in view of Asakura et al. have been **maintained**.
- The previous 103 rejections of claims 1-4, 6, 11, 13-14, and 17 over Harris et al. in view of Asakura et al. have been **maintained**.
- The previous 103 rejections of claims 7-9, 15-16 and 19 over Harris et al. have been **maintained**.

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 5 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Dalman (US 5670262) listed on IDS.

Disclosure of Dalman is adequately set forth in ¶3 of the last action and is incorporated herein by reference.

3. Claims 5 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Harris et al. (US 5741585) listed on IDS.

Disclosure of Harris et al. is adequately set forth in ¶4 of the last action and is incorporated herein by reference.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4, 6, 11, 13-14, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dalman (US 5670262) in view of Asakura et al. (US3966686).

Disclosure of Dalman and Asakura et al. are adequately set forth in ¶6 of the last action and is incorporated herein by reference.

6. Claims 1-4, 6, 11, 13-14, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harris et al. (US 5741585) listed on IDS in view of Asakura et al. (US3966686).

Disclosure of Harris et al. and Asakura et al. are adequately set forth in ¶7 of the last action and is incorporated herein by reference.

7. Claims 7-9, 15-16 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harris et al. (US 5741585) listed on IDS.

Disclosure of Harris et al. is adequately set forth in ¶8 of the last action and is incorporated herein by reference.

### ***Response to Arguments***

The argument for allowance of amended claims has been fully considered but not persuasive.

The applicant has argued rejoined process claim 12 (Pg. 5, ¶10), but this claim has been elected without traverse and the restriction was made FINAL. Claim 12 is not rejoined, because those product claims are not allowable.

The applicant has merely traversed the inherency rationale in view of Dalman or Harris et al. and/or in view of Asakura et al. without providing evidence (Pg. 5, ¶4- Pg.6, ¶1,3-4- Pg. 6, ¶1-4). The examiner has found the amendment of claim 5 with further disclosure of polyimide film producing method fail to correlate the controlling water residue, which is argued by the applicant that these references are silent on, to the claimed properties. Secondly, since the PTO does not have proper means to conduct experiments, the burden of proof is now shifted to applicants to show otherwise. A case indicating that the burden of proof can be shifted to the applicant to show that the

subject matter of the prior art does not possess the characteristic relied on whether the rejection is based on inherency under 35 U.S.C. 102 or obviousness under 35 U.S.C. 103. See MPEP § 2184. In re **Fitzgerald**, 619 F.2d 67, 205 USPQ 594 (CCPA 1980). The examiner has found no uniqueness between the claimed process, which has been argued by the applicant to allegedly provide claimed properties, and those of cited references. Thus, the examiner asserts the previous 102 and 103 rejections concerning the inherency rationale are appropriate.

The applicant has argued the disqualification of the secondary reference (Asakura et al.) for failing to disclose a polyimide film (Pg. 6, ¶14). As set for in the last action, Asakura et al. is an analogous art, because it reasonably pertinent to the particular problem, such as improving the properties of tensile strength, dielectric loss, curling, with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine all references and result in the present invention.

Therefore, the previous 102 and 103 rejections have been maintained.

Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHANE FANG whose telephone number is (571)270-7378. The examiner can normally be reached on Mon.-Thurs. 8 a.m. to 6:30 p.m. EST.. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Sf

/Randy Gulakowski/  
Supervisory Patent Examiner, Art Unit 1796